

### **REMARKS**

Claims 1, 3, 5-23, 25-36, 38-46, 48-54, 56-71, 74-89, and 91-96 are now pending and stand rejected. By this response, Applicant demonstrates reasons why the claims pending here are distinct from the asserted art. In view of the above amendments to the claims and the legal reasoning shown below to demonstrate why the 35 U.S.C. § 103 rejections are improper, Applicant respectfully submits the claims are in condition for allowance and requests the Examiner to reconsider the outstanding rejections and to withdraw them.

#### **Discussion of 112 Rejections**

Claims 1, 26, 53, 67, 81 and 86 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

Applicants submit proper disclosure in accordance with MPEP 2173.05(i) supports the negative limitation. The Examiner states that no support can be found for the limitation “without” in the disclosure. The Examiner cites MPEP 2173.05(i) stating “[a]ny negative limitation or exclusionary proviso must have basis in the original disclosure.” However, MPEP 2173.05(i) states more fully:

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph.

...

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a

prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Applicants submit that “alternative elements are positively recited in the specification,” and therefore may be excluded in the claims. Specifically, paragraph 38 (below) describes “automatically updating without any trigger by a user.” The limitation is ascertained by referring to the first line of paragraph 39 (below), which states “[i]n a particular exemplary embodiment, while list 150 may be automatically updated as described above, a user may manually alter the contents of list 150 as well.” The phrase “while list 150 may be automatically updated as described above” describes one alternative—automatically updating without any trigger by a user. Another alternative is described by the phrase “a user may manually alter the contents of list 150 as well”—updating due to a trigger by a user. As stated in the MPEP, these two recitations constitute “alternative elements positively recited in the specification” and reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. For example, the following paragraphs meet the requirements of § 112, second paragraph:

*“[0038] In an exemplary embodiment, list 150 may be updated prior to transmission to reflect the current state of applications 155 included in electronic device 100. Thus, in response to a request to receive electronic information 142, an application 155 in a web browser or elsewhere in electronic device 100 examines the applications included in electronic device 100 to determine every supported data format. List 150 may also be updated in response to changes in applications 155 as they occur. If an application 155 is added to or removed from electronic device 100, list 150 may be updated to include or exclude data formats affected by the installation or removal. Additionally, if a file compatibility error has occurred, such that data formats normally supported by a particular application 155 may not be used by the application as currently configured, list 150 may also be updated to reflect that fact. File compatibility errors may occur when a portion of the application 155 has become corrupt or inoperable, such that certain data formats previously supported may not be utilized by the application 155. Viruses or changes to the operating system, among other things, may cause the file compatibility errors.*

*[0039] In a particular exemplary embodiment, while list 150 may be automatically updated as described above, a user may manually alter the contents of list 150 as well. In certain situations, a user may wish to prevent certain supported data formats from being transmitted to electronic device 100. For*

*example, certain graphic or video files may be supported by applications in electronic device 100 but may be too large to transfer efficiently over a wireless connection. In another situation, the files may cause a drain in system resources (e.g., permanent memory space, random access memory, etc.). In these cases, the user may override the inclusion of particular data formats in list 150. A user may select an option to exclude all graphics or video formats, or may choose individual formats from a list of included formats. In the opposite situation, a user may wish to include unsupported data formats in list 150. For example, a user may wish to receive certain information 142 in electronic device and then transfer that information to another device having applications which support its particular data format. Here, the user would simply add the particular data format to list 150 despite the fact that application 155 included in electronic device 100 may not itself use information 142."*

Moreover, Applicants respectfully direct the Examiner's attention to MPEP 2173.05(i) stating "[t]he mere absence of a positive recitation is not basis for an exclusion....that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support." Even if the Examiner considers the above passages as not "positively" reciting the limitation, a sufficient basis (as described above) exists in the disclosure to support the negative limitation. As such, the boundaries of the protection sought are set forth definitely complying with 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request withdrawal of this rejection.

## **Discussion of 103 Rejections**

### ***1. Legal Construct Governing 35 U.S.C. § 103 Rejections***

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a prima facie case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be "expansive and flexible" and "functional." However, the standard is not controlling, rather, the various

noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in KSR stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in KSR has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art **teaches away** from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

## 2. 35 U.S.C. § 103 Rejections

Claims 1, 3, 5-19, 23, 25-27, 29-30, 32-33, 35, 38-39, 41-44, 46, 48-51, 53, 56-59, 67-69, 71, 74-75, 78-80, 86, 88-89, 91-92, and 93-94 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Janakiraman et al., U.S. Patent Application Publication No. 2002/0124020, in view of Nelson et al., U.S. Patent No. 6,498,897 and further in view of U.S. Patent No. 6,877,037 to Adachi. Applicants respectfully traverse this rejection because the combination of Janakiraman, Nelson, and Adachi do not teach or suggest each and every element of the claims.

For example, with respect to claims 1, 23, 25, 46, 53, 67 and 86, Janakiraman does not disclose the following elements:

- sending a list of supported formats from the electronic device to a proxy server.

Applicants agree with the Examiner that Janakiraman not send a list of support formats from the device to the proxy server. The reason Janakiraman's disclosure is silent is because it does not support the concept of a proxy server or supported formats.

- using the proxy server to determine whether the electronic data has a supported format.

Janakiraman does not disclose a proxy server or the concept of supported formats. As Applicants have disclosed supported formats are data formats normally "supported by, or compatible with," the applications on the electronic device. See p. 13, para. 0037. In Janakiraman, no "supported format" determination is made. In fact, supported formats are irrelevant. Janakiraman merely searches a file, any file, already received at the client for tags that identify whether a particular file has textual equivalents for multimedia. See para. 0015-0016 and 0025. If it finds such tags, the browser displays the textual equivalents. **Format is irrelevant.** In other words, Janakiraman does not determine supported format compatible with a client, it determines whether a text attribute exists for a specific format, and then outputs the tagged material. The format of the file remains unchanged as the complete file is always downloaded to the client. This fact alone teaches away from the present claims where only supported **formats** are downloaded to the electronic device in order to conserve bandwidth. Janakiraman is completely unconcerned with bandwidth conservation.

- automatically issuing a transfer instruction from the proxy server for the electronic data based on acceptability criteria, the acceptability criteria comprising whether the electronic data has a supported format; wherein the transfer instruction includes an instruction to only send the electronic data if the electronic data has a supported format.

Janakiraman does not disclose the concept of transfer instructions or acceptability criteria as claimed. The citations provided by the Examiner also reveal that Janakiraman teaches away from the present invention as claimed. For example, Janakiraman discloses:

Method 300 is a method of extracting textual equivalents in multimedia files, e.g., images, video, audio, that are used to produce web pages in order to promote accessibility to individuals with disabilities.

In step 301, web page engine 11 of web server 110 may be configured to forward an HTML file specifying one or more multimedia files to client 120 so that the web browser 122 of client 120 may output textual equivalents of the multimedia content in the one or more multimedia files to display 238, Braille display 242, speech synthesizer 242 and speaker 230 of client 120.

In the example, the complete file has already been downloaded to the client—i.e., the client, not a proxy server as claimed, issues an instruction for download. Moreover, no acceptability criteria were applied in downloading the file. Even if acceptability criteria could somehow be construed to be within Janakiraman's disclosure of the extraction process, this "criteria" would have been applied **after** download of the file electronic file. As such, the client is responsible for extracting the text tags. See paragraph 0042. This defeats one of the purposes of the present invention as claimed, that is, to prevent the download of unsupported material over a bandwidth-constrained wireless connection. Not only does the application of Janakiraman not apply to the present claims, its disclosure teaches away from the claims.

- automatically updating without any trigger by a user the list of supported formats to reflect the changes in applications included in the electronic device.

The Applicants agree with the Examiner that Janakiraman does not teach updating the list of supported formats. As such, Janakiraman does not teach, alone or in combination, the elements of the present claims. For this reason alone, Applicants submit the claims are allowable over the cited prior art.

Nelson does not cure any of Janakiraman's deficiencies. Nelson's disclosure teaches away from the combination. For example, Nelson relies on the client to play the select the proper format ("the client side media control application is enabled to select the appropriate format and application for playback based upon the specific characteristics of the client system." Col. 2, lines 50-52.). This teaching is diametrically opposed to "using the proxy server to

determine whether the electronic data has a supported format.” As stated above, Janakiraman forces the client to perform its extraction process. Combining Janakiraman and Nelson still results in a combination that does not disclose the elements of the present claims.

Moreover, Nelson is not combinable with Janakiraman because Janakiraman does not use nor have a need for a proxy server. Furthermore, neither disclosure supports combination. Janakiraman is method for making files, such as web pages, more accessible for people with disabilities. Nelson’s process is directed towards injecting artificial headers into complex multimedia assets. Nothing is mentioned in Nelson about making files more accessible to those systems used by people with disabilities. Combination of such disparate references is achieved only through impermissible hindsight construction. For these reasons alone, Applicants submit the claims are allowable over the cited prior art.

Adachi does not cure the deficiencies of the Janakiraman and Nelson combination. Adachi discloses updating software on mobile devices with the proper version of data. Adachi teaches nothing about supported formats to reflect changes in applications in the electronic device. Adachi describes sending a mobile client the most recent version number of data should there be a mismatch of version numbers between the mobile client and the server. It is well known that versions of data/file/application and the format of data/file/applications file are two completely disparate concepts. For example, many versions data may exist wherein all the versions of the data or the file containing the data are of the same format. Knowing this fact provides one of ordinary skill in the art with **no** motivation whatsoever to combine Adachi with any of the other cited references. For this reason alone, Applicants submit the claims are allowable over the cited prior art.

Applicants further submit that Janakiraman, Nelson, and Adachi are not combinable because their disclosures do not contemplate the same or similar problems. Any attempted combination can only be accomplished with the aid of Applicants’ disclosure. Moreover, even if a combination could be made, no combination of these references teaches or suggests each and every element of the claims. Accordingly, Applicants respectfully request withdrawal of this rejection.



Claims 20-22, 34, 45, 52, 60, 76-77 and 95-96 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Janakiraman, Nelson, and Adachi as applied to claims 1, 23, 35, 46, 53, 67, and 86 above, and further in view of Schwartz (U.S. Patent No. 6,473,609). Applicants respectfully traverse this rejection.

As stated above, no combination of Janakiraman, Nelson, and Adachi teach the elements of the present claims. Schwartz does not cure the deficiencies of the combination. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 28, 31, 36, 54, 70 and 87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Janakiraman, Nelson and Adachi as applied to claims 23, 53 and 86 above and further in view of Timothy et al., "Web Page Filtering and Re-Authoring for Mobile Users," (hereinafter Timothy). Applicants respectfully traverse this rejection.

As stated above, no combination of Janakiraman, Nelson, and Adachi teach the elements of the present claims. Timothy does not cure the deficiencies of the combination. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 61-62, 64-65 and 81-82 stand rejected under 35 U.S.C. as unpatentable over Janakiraman in view of Castell (U.S. Patent Application Publication No. 2002/0132607). Applicants respectfully traverse this rejection.

As stated above, Janakiraman does not teach the elements of the present claims. Castell does not cure Janakiraman's deficiencies. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 63 and 83-84 stand rejected under 35 U.S.C § 103(a) as being unpatentable over both Janakiraman and Castell as applied to claims 61 and 81, and further in view of Adachi. Applicants respectfully traverse this rejection.

As stated above, Janakiraman and Adachi do not teach the elements of the present claims. Castell does not cure Janakiraman and Adachi's deficiencies. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 66 and 85 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over both Janakiraman and Castell as applied to claims 61 and 81 above, and further in view of Schwartz et al. Applicants respectfully traverse this rejection.

As stated above, Janakiraman and Castell do not teach the elements of the present claims. Schwartz does not cure Janakiraman and Castell's deficiencies. Accordingly, Applicants respectfully request withdrawal of this rejection.

### ***Conclusion***

Applicant respectfully submits the claims are in condition for allowance and requests withdrawal of all rejections. In the event there are outstanding issues, the Examiner is requested to call the undersigned to resolve them.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: April 29, 2009

By:       /Shawn Diedtrich/        
Shawn Diedtrich  
Registration No 58,176  
Phone: 480.704.4615

### **Correspondence Address**

**Cust. No. 49637**

Berry & Associates, P.C.  
9255 Sunset Boulevard, Suite 810  
Los Angeles, CA 90069  
Phone: (310) 247-2860  
Fax: (310) 247-2864